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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/846,032 | 04/30/2001 | Jonathan McFarland | 884.424US1 | 4299 |

7590 08/13/2003

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
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| EXAMINER |
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ULLAH, AKM E

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| ART UNIT | PAPER NUMBER |
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2874

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,032

Applicant(s)

MCFARLAND ET AL.

Examiner

Akm Enayet Ullah

Art Unit

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The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE thirty MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 27, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

So Called Serial no 09/84632

Note that Applicant's amendment and response under 37 CFR 1.111, dated May 27, 2003 (paper no.6) has an error on its heading from pages 2-9. It should be 09/ 846, 032 as it mentioned on page 1 of the response.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to an interconnection device, classified in class 385, subclass 39.
- II. Claims 11-13, drawn to a method of fabricating an interconnect, classified in class 156, subclass 247.
- III. Claims 14-23, drawn to an electronic package, classified in class 385, subclass 14.

Unrelated Inventions

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

In the instant case the different inventions Group I relates to an interconnection device between an optical transmissive unit and an isotropic conductive film and also the optically transmissive unit optically couples each of a plurality of optical transmitters to one or more optical receivers where Group II relates to a method of fabricating an interconnect by laminating the anisotropic conductive film on substrate, and etching the holes in the patterned anisotropic conductive film where Group III relates to an electronic package having a first substrate, second substrate which are interconnect, a conductive film for electrically coupling along with first & second substrate and also at least one optically transmissive unit embedded in the conductive film.

The interconnection of Group I claims 1-10 does not include the specific details of the method of fabricating the interconnecting device of the Group II and could readily function without it. The interconnection of Group I claims could obviously be employed to connecting signals between film and transmissive unit other than that specifically recited steps in group II claims and/or the electronic package of Group III. Furthermore, the searches for the devices as grouped is not co-extensive in that the Group II would require a search for the details of the method for fabricating the interconnection by laminating the film and by etching the holes which would not normally searched for the interconnection device of the Group I claims and/or the electronic package of Group III.

Conclusion To All Restriction Requirements

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, a separate status in the art because of their recognized divergent subject matter and

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also the search required for invention I or II is not required for invention III restriction for examination purposes as indicated is proper.

Requirement, Election, Mailed

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant(s) are given thirty days (30) from the date of this letter to provide the election, as indicated above so as to avoid the question of abandonment.

Requirement, No Election By Telephone

A telephone call was made to Mr. Danny J. Padys (Reg.no. 35,635) on August 06, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Joint Inventors, Correction of Inventorship

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Arguments Are Moot Because of New Ground Of Rejection

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Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection (restriction requirement).

Contact Information

Any inquiry concerning this communication should be directed to Akm Enayet

Ullah at telephone number 703-308-4885.

A handwritten signature in black ink, appearing to read 'A. Ullah', with a long horizontal flourish extending to the right.

Akm Enayet Ullah
Primary Examiner
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